

**REMARKS**

The office action mailed June 28, 2006 has been carefully considered. Within the office action Claims 1-27 have been rejected. The applicants have amended Claims 1 and 12 and have canceled Claims 10, 11, 21, 24 and 25. The applicants reserve the right to pursue the canceled claims in the continuation and/or divisional application as well as for appeal purposes. In addition the applicants have added new Claims 28-36. Reconsideration in view of the above amendments and following remarks is respectfully requested.

**Information Disclosure Statement**

The applicants had previously filed an information disclosure statement (IDS) with the USPTO on February 23, 2004. However, the examiner stated in the office action that the information disclosure statements filed on February 23, 2004 and September 30, 2004 failed to comply with 37 C.F.R. 1.98(a)(2) which requires a legible copy of each foreign patent document and each non-patent literature publication which is listed in the information disclosure statement. The applicants respectfully traverse.

Regarding the non US patent documents cited in the September 30, 2004 IDS, the applicants have provided paper copies of these references with this response.

Regarding the non US patent documents cited in the February 23, 2004 IDS, 37 C.F.R. §1.98(d) specifically recites that a copy of the patent, publication, pending U.S. application or other information must be submitted **unless** an earlier parent application containing such reference is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120. As recited in the information disclosure statement filed on February 23, 2004 (copy attached herewith), it is stated that no copies of the publication listed in the form PTO/SB/08A are being provided pursuant to 37 C.F.R. 1.98(d),

because the publications were previously cited or submitted to the Patent Office in the prior application Serial No. 09/741,310 to which this application claims priority under 35 U.S.C. 120. Accordingly, copies of the foreign patent application patents and/or non-patent publication references do not need to be provided in the present case under 37 CFR 1.98(d) considering that they were provided in the parent application No. 09/741,310. Accordingly, the applicants respectfully submit that the paper copies are not required to be submitted again for the references cited in the February 23, 2004 IDS and request that the foreign patent documents and non-patent publications be considered.

#### Judicially-created Double Patenting

Within the office action, Claims 1-27 were rejected for allegedly being unpatentable under the non-statutory obviousness type double patent rejection of U.S. Patent No. 6,184,868. The applicants respectfully traverse.

The applicants have amended claims 1 and 12 and have cancelled Claim 10 not for reasons related to the Double Patenting rejection. In addition, the applicants have added new Independent Claim 34 which the applicants submit may be patentably distinct from the claims in 6,184,868. In addition, the applicants would like to point out that the examiner has only made a comparison between only Claim 1 and US 6,184,868 and did not provide a comparison with regards to Claims 10, 12 and new Claim 34 in light of 6,184,868. M.P.E.P. 806.03. ("In passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.")

However, the applicants are willing to submit a terminal disclaimer statement to overcome this rejection and will do so if the examiner finds that the currently pending claims are still not patentably distinct over US 6,184,868. Accordingly, the applicants respectfully requests reconsideration of this rejection with the currently pending claims.

Rejection under U.S.C. § 102

Claims 1-21 and 23-27 stand rejected under 35 U.S.C. 102(b) as being allegedly anticipated by U.S. Patent No. 5,790,108 to Salcudean et al. (hereinafter referred to as “Salcudean”). The applicants respectfully traverse.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Salcudean discloses a mouse controller which includes a moveable platform 18 mounted on a base 12, whereby the platform 18 has a range of movement in a plane relative to the base. Figures 6 and 7 of Salcudean show the moveable platform 18, whereby the moveable platform 18 has a housing and an actuator button 20 as well as a separate tactile element 22 extending therefrom. Figure 6 of Salcudean shows a microswitch 118 which is coupled to the button 20 as well as an E-core type magnet 120 which is coupled to the tactile element 22. The button 20 actuates a micro switch 118 whereas the tactile element 22 is controlled by the E-core type magnet 122. A pair of springs 128 and 130 in the E-core magnet 120 hold the tactile element 22 to its lower most position closest to the core 122. Salcudean discloses that when the coil is activated it causes the tactile element to move upwardly away from the core 122 with the amount of movement being dependent on the current in the coil 124. The position of the tactile element 22 is such that it contacts with the hand of the user and when activated applies pressure

thereagainst, the pressure being proportional to the amount of current passing through the coil

124. Salcudean goes on to describe that other types of handles may be used, such as the joystick control handle 131 in FIG. 8 which has controller buttons 132 and tactile elements 134, 136 and 138, whereby the tactile elements 134, 136 and 138 operate like the tactile element 22.

Salcudean, however, fails to teach a coupling member which is coupled to a moveable portion and a fixed portion of the housing wherein the coupling member is configured to allow selective movement of the moveable portion with respect to the fixed portion, as recited in Claim 1. Within the office action, the Examiner associates the fixed portion in Claim 1 to be the Salcudean base 12 and the moveable portion in Claim 1 to be the mouse 18 of Salcudean. In addition, the Examiner associates the coupling member in Claim 1 to be the E-core magnet 122 Salcudean. If this were the case, Salcudean would not teach that the E-core magnet 122 is associated with the base 12, because the E-core magnet 122 does not control or allow selective movement of the mouse 18 with respect to the base 12. Instead, the E-core magnet 122 merely activates the magnetic coil 124 to press the tactile element 22 in the up direction when activated. Accordingly, Claim 1 is distinguishable over Salcudean and for at least these reasons Claim 1 is allowable over Salcudean.

Claim 12, recites, among other things, a button which is depressible along a degree of freedom, an actuator which is coupled to the button, a sensor which is configured to detect a displacement of the button along the degree of freedom when depressed; and a processor coupled to the actuator and configured to send a signal to the actuator based on the detected displacement, the actuator configured to generate a haptic feedback at least along the degree of freedom based on the signal. In contrast to Claim 12, Salcudean does not teach that a sensor is configured to detect the displacement of the button when it is depressed or that the processor is coupled to the actuator and provides a haptic feedback to the button based on the detected displacement. In

addition, Salcudean does not teach that the actuator applies a haptic feedback to the button along its degree of freedom. Instead, Salcudean only teaches that the button is coupled to the microswitch 118 and that the coupling member 122 and actuator 124 only operates on the tactile element 22. In other words, there is no teaching in Salcudean that the actuator 124 provides haptic feedback to the button 20 along the degree of freedom. Accordingly, Salcudean does not teach and every element of Claim 12 and accordingly Claim 12 is distinguishable over Salcudean.

Claims 2-9 are dependent on Independent Claim 1; and Claims 13-21 and 23-27 are dependent on Independent Claim 12. As stated above, Claims 1 and 12 are allowable over Salcudean. Accordingly, Claims 2-9 and 13-21 and 23-27 are allowable for being dependent on allowable base claims.

#### Rejection under 35 U.S.C. § 103

Within the office action Claim 22 stands rejected under 35 U.S.C. as being allegedly unpatentable over Salcudean. Claim 22 is dependent upon Claim 12 which is an independent claim. As stated above, Claim 12 is allowable over Salcudean. Accordingly, Claim 22 is allowable for being dependent on a base claim.

#### New Claims

Claims 28-36 have been added by the applicants. The applicants respectfully submit that the subject matter claimed in Claims 28-36 are fully supported by the specification and do not contain any new matter.

New Claim 34 recites, among other things, sensing a movement of a button along a degree of freedom, the button being of a moveable portion of the manipulandum wherein the

moveable portion moves along the substantially same plane with respect to a surface of a fixed portion of the manipulandum. Claim 34 also recites receiving a first haptic feedback signal based on the first control signal and outputting the first haptic feedback to the button along the degree of freedom in response to the first haptic feedback signal.

As stated above, Salcudean does not teach outputting the haptic feedback to the button along the degree of freedom. Instead, Salcudean only discloses that the actuator operates the tactile element 22. In addition, Claim 34 recites receiving a second haptic feedback signal from the processor based on a second control signal and outputting a second haptic feedback to the moveable portion of the manipulandum in response to the second haptic feedback signal. There is no hint, teaching or suggestion in Salcudean to apply a second haptic feedback signal to the mouse itself. For at least these reasons, Claim 31 is patentable over Salcudean individually or in combination with another reference.

The examiner is respectfully requested to review new dependent Claims 28-33 as well as 35-36 as the applicants respectfully submit that these new claims are allowable over Salcudean individually or in combination. Accordingly, the applicants respectfully request allowance of Claims 28-36.

Conclusion

It is believed that this Response places the above-identified patent application into condition for allowance. Early favorable consideration of this Response is earnestly solicited.


If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

Dated: 9/27/06

  
Suvashis Bhattacharya  
Reg. No. 46,554

Thelen Reid & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel. (408) 292-5800  
Fax. (408) 287-8040